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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,696	07/21/2003	Wen-Chieh Wang	WANG3188/EM	4393
23364	7590	06/01/2005	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			PAPE, ZACHARY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,696

Applicant(s)

WANG ET AL.

Examiner

Zachary M. Pape

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/4/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The examiner has reviewed applicant's comments in regards to the finality of the rejection as set forth on the correspondence dated 5/4/2005, and finds the applicants argument to be persuasive. Therefore the finality of the previous action has been WITHDRAWN. The following action on the merits is in response to the applicant's remarks of 5/4/2005.

Additionally the examiner has withdrawn the 112 rejection as stated in the previous office action dated 2/18/2005 since the applicant has provided sufficient detailed material in the correspondence dated 5/4/2005 to clarify what exactly a "standard 85-key keyboard" is.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,6,7 rejected under 35 U.S.C. 103(a) as being unpatentable over Gaultier (Patent # 5,758,297), in view of Paajanen et al. (Patent # 5,189,632) and further in view of Bae (Patent # 6,640,114). With respect to claim 1, Gaultier teaches a portable computer (encased in a shell) having a hidden keyboard structure (6), comprising: a shell having a top face (1), and four peripheral sides (as illustrated in Fig 2), said shell having installed in said top face thereof an LCD panel (2, Column 2, Lines

57-58) and an alphanumeric keyboard (6, Column 2, Lines 64-65), a protecting cover (5) pivoted to one of said peripheral sides adjacent to the keyboard of said shell by a coupling means thereof and adaptable to cover said keyboard (Column 2, Lines 66 – Column 3, Lines 1-2), said protecting cover having an outer face (As illustrated in Fig 1), an inner face opposite to said outer face (As illustrated in Fig 2). Gaultier fails to teach a plurality of buttons located on said outer face, and a cursor controlling device located on said inner face; and a cable device connected between said shell and said protecting cover for transmitting signals from said buttons and said cursor control wherein said cursor controlling device is a touchpad.

Paajanen et al. teaches the use of a plurality of buttons (6) located on the outer face of a personal computer cover. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the buttons located on the exterior of the cover of Paajanen et al. with the cover and PC of Gaultier to provide an additional means for inputting data into the CPU while the cover is closed. (Buttons could be placed such that they avoid interfering with the tablet portion (F-P) on the front cover such as along the side, etc.) Further operating the PC of Gaultier with the external keypad on the cover allows for the cover to remain closed while operating the keyboard thus reducing unnecessary bulk.

Further Bae teaches the use of a touchpad (24) located on the interior of a cover for a cellular phone and a means of coupling the touch pad (24) to the processor (28, Column 3, Lines 1-3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the touchpad located on the inside of the

cover and PC of Gaultier to provide an alternative and more versatile means for navigating through the software. Further the coupling device provides a required medium for which data can transfer between any devices located on the cover and the CPU.

With respect to claim 2, Bae fails to further disclose that the cable device includes a flexible printed circuit. However the use of flexible printed circuits are notoriously old and obvious to one of ordinary skill in the art as a versatile means to connect two electronic devices.

With respect to claim 3, Gaultier further teaches that the shell further includes a plurality of buttons (3,4) on the top face for signal input.

With respect to claim 6, Gaultier further teaches the use of an alpha-numeric keyboard (As illustrated in Fig 3), but fails to teach that it is a "standard 85-key keyboard". It would have been obvious to one of ordinary skill in the art at the time the invention was made to use either the keyboard of Gaultier or any other "standard" keyboard as an alternate equivalent means of data entry. Regardless of how many keys are present, both "standard" keyboards and the keyboard of Gaultier allow for general alpha and numeric data entry.

With respect to claim 7, Gaultier further teaches that the portable computer is a tablet PC. (The PC can be used as a tablet as described in Column 3, Lines 2-8)

### ***Response to Arguments***

3. Applicant's arguments filed 5/4/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the Paajanen reference with Gaultier, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicants remarks that there is, "no motivation to combine", and, "further that Gaultier teaches away from, rather than suggest, the combination" is non persuasive. As stated by the examiner in the current office action, the buttons could be positioned on the front cover such that they would not interfere with the use of the cover as a clip board type function as taught by Gaultier. An example of such placement would include along the outside edge of the cover as detailed in the present office action Fig 1 below.

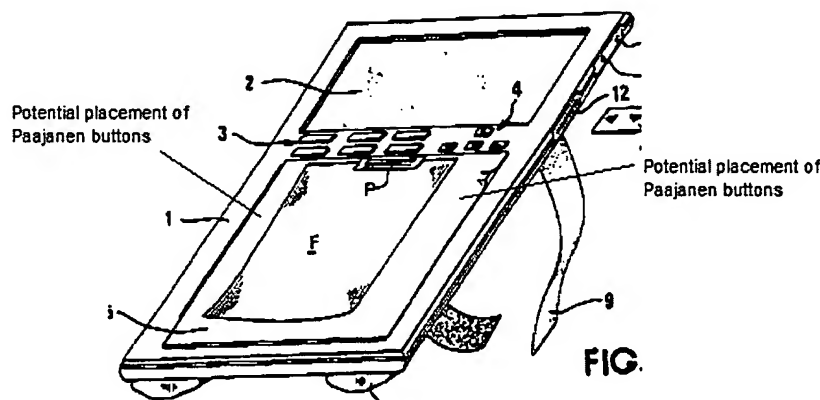


Fig 1

In response to the applicants remarks that "Gaultier already provides a numeric keyboard on the main keyboard area (6) further belying the need or desirability to modify the outside of the cover as suggested by the examiner", the examiner respectfully cites the previous office action dated 2/18/2005 where the examiner provides further motivation stating, "external keypad on the cover allows for the cover to remain closed while operating the keyboard thus reducing unnecessary bulk". Placing the keys on the outside would remove the need of the user to have to open up the cover to access the internal set of keys. Additionally the examiner cites that the applicant did not specifically mention in the claims that the keys located on the outside cover are numeric.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Since the applicant did not specify in the claims where the external buttons are to be placed on the cover, the examiner is at liberty to at the very least suggest that the buttons be placed such that they do not interfere with the clipboard function of the cover. Additionally, it would be obvious to one of ordinary skill in the art when

combining the Paajanen et al. reference with Gaultier to place the buttons in a place where they would not interfere with the clipboard function of the cover.

In response to applicant's argument that there is no suggestion to combine the touch pad of Bae with the tablet PC of Gaultier, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is not a matter of whether Gaultier would require or even desire the use of the touchpad of Bae that is of issue, rather would one of ordinary skill in the art at the time the invention was made recognize a motivation to combine the two references. As suggested by the examiner in the previous office action dated 2/18/2005, one **possible** motivation for combining the touchpad of Bae with the Gaultier reference is "to provide an alternative and more versatile means for navigating through the software". The examiner points out that it is common and well known in the art to have multiple methods of navigating through software on personal computers. For example, on a standard laptop computer, such as the "Versa Aptitude" as brought in by reference by the applicant, not only can the user use the keys on the keyboard to navigate through the software, they could also use the touchpad as a more versatile (and potentially less cumbersome) means to navigate through the software. By



combining the Bae reference with Gaultier, the user of the modified PC would have the option of using either the keys as taught by Gaultier or the touchpad as taught by Bae.

In response to applicant's arguments against the Bae reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore the argument that the Bae reference doesn't further include the external buttons as taught by Paajanen et al. is improper since the Bae reference is not required to contain all the other claim limitations as claimed by the applicant.

### ***Conclusion***

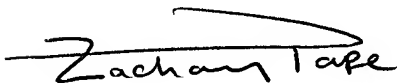
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary M. Pape whose telephone number is 571-272-2201. The examiner can normally be reached on Mon. - Thur. & every other Fri. (8:00am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached at 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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